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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,296	08/10/2001	James C. Thomas JR.	45659/FLC/T503	4976
23363	7590	02/16/2005	EXAMINER	
CHRISTIE, PARKER & HALE, LLP PO BOX 7068 PASADENA, CA 91109-7068			GORT, ELAINE L	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 02/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/927,296

Applicant(s)

THOMAS, JAMES G.

Examiner

Elaine Gort

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-32 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 23-32 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 23-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shop - The Card You Pick Can Save You Money in view of The Profitability of Credit Card Operations of Depository Institutions and Examiner's Official Notice.

Shop - The Card You Pick Can Save You Money discloses the claimed data processing system adapted to provide rebates for charges made to a credit card but is silent regarding a link between a credit card account and an insurance policy where the insurance account is credited with the rebate.

The Profitability of Credit Card Operations of Depository Institutions discloses that it is known in the art to provide a credit card with a link between a credit card account and another account which is credited with a rebate (see beginning on 8th paragraph on page 7 which discusses credit cards bearing the name of and marketed to consumers of co-branded products) to simultaneously promote the credit card and the co-branded products. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the system of Shop - The Card You Pick Can Save You Money with the link between a credit card account and another account

Art Unit: 3627

which is credited with the rebate as taught by The Profitability of Credit Card Operations of Depository Institutions, in order to promote the card and the co-branded products.

Examiner takes Official Notice that the use of memory, executable program instructions and processors is notoriously old and well known in the art of credit card usage and accounting to provide automated use, tracking and billing of credit card accounts. It would have been obvious to one having ordinary skill in the art at the time the invention was made to perform the rebate calculation and crediting of Shop - The Card You Pick Can Save You Money and The Profitability of Credit Card Operations of Depository Institutions, as modified above, with the use of memory, executable program instructions and processors of Examiner's Official Notice in order to provide automated use, tracking and billing of credit card accounts with rebates.

Shop - The Card You Pick Can Save You Money, The Profitability of Credit Card Operations of Depository Institutions and Examiner's Official Notice, as modified above, does not expressly show the claimed data including: where the credited account is an insurance account. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The program instruction steps would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Note that the system is "capable" of carrying out the claimed steps on any type of data and therefore is capable of crediting an insurance account.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to perform the step of generating a link, calculating a rebate, identifying the account, crediting the account and applying the rebate amount to the account using any type of data. Because such data does not functionally related to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention. It further would have been obvious to carry out these claimed program instructions on an insurance account in order promote a credit card to insurance customers in order to promote both card and the co-branded products being the insurance companies products.

Functional recitation(s) used in apparatus claims (e.g. "for charges made to a credit card as payment for insurance policies" as recited in claim 23) are given little patentable weight because they fail to add any structural limitations and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In re Casey, 152 USPQ 235 (CCPA 1967); In re Otto, 136 USPQ 458, 459 (CCPA 1963)

Regarding claim 24, Examiner takes Official Notice that the use of Web Sites for viewing credit card account information is notoriously old and well known in the art of credit card billing to provide users with on-line up to date access to account information.

Regarding claims 25-28, Examiner takes Official Notice that it is notoriously old and well known in the art of rebate calculations to utilize fixed or variable percentages for calculating credit card rebates for marketing purposes.

Response to Arguments

3. Applicant's arguments with respect to claims 23-32 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

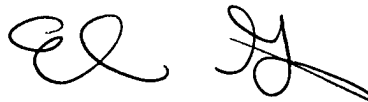
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 3627

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elaine Gort whose telephone number is (703)308-6391. The examiner can normally be reached on Monday through Thursday from 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached at (703)308-5183. The fax phone number for the organization where this application or processing is assigned is (703)872-9327.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.



Elaine Gort
Examiner
Art Unit 3627

February 11, 2005



ROBERT P. OLSZEWSKI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600